

## **REMARKS**

### **I. General**

Claims 1 – 55 are presently pending in the application. The issues in the current Office Action are as follows:

- Claims 1 – 9 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Publication No. 2002/0103935 to Fishman et al. (hereinafter “Fishman”) in view of U.S. Patent Publication No. 2003/0097463 to Kageyama et al. (hereinafter “Kageyama”).
- Claims 10, 32, 43 – 44 and 51 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Kageyama in view of U.S. Patent Publication No. 2003/0193951 to Fenton et al. (hereinafter “Fenton”).
- Claims 11 – 21, 24 – 29, 31, 33 – 42, 45 – 50 and 52 – 55 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Kageyama and Fenton as applied to parent claims 1, 10 and 32 above in view of U.S. Patent Publication No. 2004/0249768 to Kontio et al. (hereinafter “Kontio”).
- Claims 22 – 23 and 30 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Kageyama, Fenton and Kontio as applied to parent claim 24 above in view of U.S. Patent Publication No. 2005/0256937 to Lewis (hereinafter “Lewis”).

Applicants appreciate the courtesy and professionalism extended by the Examiner thus far. Applicants hereby traverse the rejections and request reconsideration and withdrawal in light of the amendments and remarks contained herein.

### **II. Claim Amendments**

Claims 1, 10, 32 and 43 have been amended. Support for these amendments may be found at least at paragraphs [0007], [009], [0024] and [0027] of the specification. As such no new matter has been introduced by these amendments.

### **III. Claim Rejections**

#### **A. 35 U.S.C. § 103(a) Rejection over Fishman in view of Kageyama**

Claims 1 – 9 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Fishman in view of Kageyama. The differences between claims and the applied art is one of the factors to be considered in determining obviousness. *See Graham v. John Deere Co.*, 383 U.S. 1, 15 - 17 (1966). Fishman in view of Kageyama is different from claims 1 – 9, as amended, and thus do not teach all the limitations of claims 1 – 9. As discussed below, at least for this reason, the claims are patentable over Fishman in view of Kageyama.

#### **1. Claim 1**

Claim 1, as amended, recites, “wherein said stored content is received from a device other than said first user device . . . .” Significantly, claim 1 also requires that information is accepted from the first user device. Examiner relies on Fishman, Fig. 2 and the abstract as teaching the limitation pertaining to accepting information in claim 1. Fishman, however, fails to teach that the stored information is received from a device other than the first user device (i.e. the user device from which information is accepted with respect to the stored content). Instead, Fishman teaches that the content stored in content server 210 (Fig. 2, e-mail data object to A, B & C) originates from a first user device, i.e. the device sending data object A, B and C. Abstract, paragraph [0034]. In other words, all the content stored on content server 210 and information pertaining to that content that is delivered to a second user device is sent from the first user device. This is a non-obvious difference between Fishman and claim 1. Kageyama does not compensate for this difference between Fishman and claim 1.

Moreover, the method of claim 1 is not only different from Fishman in view of Kageyama, it also offers significant advantages in the field of multimedia messaging. As described in paragraphs [0001] to [0006] of the specification as originally filed, there are significant disadvantages in requiring a user of a device to take custody of large files on the user’s user device that may have limited capacity in order to send those large files to others.

Consequently, the specification provides the following with regard to embodiments of the invention:

In operation according to a preferred embodiment, a sending user does not need to obtain possession of all, or even any portion, of content forming a message, but instead sends an abbreviated message to a referral gateway of the present invention, invoking the referral gateway to arrange for the delivery of a message including the proper content to a selected recipient or recipients. Paragraph [0007].

This advantage over the applied references is relevant to the determination of obviousness. In *In re Chu*, 66 F.3d 292, 298 36 USPQ2d 1089 (Fed. Cir. 1995) the Federal Circuit held “the matter of any purported advantage” proffered by an applicant should be considered in the totality of the record in an obviousness determination.

In sum, claim 1 has limitations that are different and non-obvious over the applied art references. Accordingly, Applicants respectfully request that Examiner withdraw the rejections, under 35 U.S.C. § 103(a), of claim 1.

## **2. Claims 2 – 9**

Claims 2 – 9 depend from claim 1 and inherit the limitations of claim 1. As discussed above, Fishman in view of Kageyama do not teach all the limitations of claim 1. At least for this reason, Fishman in view of Kageyama does not render claims 2 – 9 obvious. Moreover, the dependent claims recite non-obvious limitations not taught by the applied art references.

For example, claim 2 recites “wherein said first user device and said second user device are associated with a same user, and wherein said first user device and said second user device provide said content to said user using different media modes.” Claim 5 recites, “wherein said first user device and said second user device provide said content to respective users thereof using different media modes.” Examiner relies on Fishman Fig. 2, elements A, B, C and paragraph [0004] for teaching these limitations of claims 2 and 5.

These cited portions of Fishman, however, do not teach the limitations of claims 2 and 5. Instead, these portions of Fishman merely show the different user devices that can be used

in Fishman and that a user may own several of these user devices. Therefore, Fishman does not teach the limitation of claim 2 requiring “wherein said first user device and said second user device are associated with a same user, and wherein said first user device and said second user device provide said content to said user using different media modes.” Similarly, Fishman also fails to teach the limitation of claim 5 requiring “wherein said first user device and said second user device provide said content to respective users thereof using different media modes.”

In sum, Fishman in view of Kageyama do not teach all the limitations of claims 2 – 9. Accordingly, Applicants respectfully request that Examiner withdraw the rejections, under 35 U.S.C. § 103(a), of claim 1.

**B. 35 U.S.C. § 103(a) Rejection over Kageyama in view of Fenton**

Claims 10, 32, 43 – 44 and 51 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Kageyama in view of Fenton. As discussed below, Kageyama in view of Fenton does not teach all the limitations of claims 10, 32, 43 – 44 and 51.

**1. Claim 10**

Claim 10 as amended, recites, “wherein said stored content is received from a device other than said first user device . . . .” Significantly, claim 10 also requires that a message including identification of certain content is received from the first user device. Kageyama in view of Fenton does not teach these limitations of claim 10. Instead, Kageyama teaches a user device capable of negotiations pertaining to the disclosure of attribute information. Abstract. The user device negotiates with a center device the information that may be shared with a second device. *Id.*; Paragraph [0057]. Kageyama, however, does not show that information stored is received from a device other than the first user device or a first user (i.e. the user device or user from which a message is accepted with respect to the stored content).

Fenton discloses a system for processing multimedia messages. Abstract. In Fenton, when a message is received, a determination is made whether the multimedia message should be processed using a customized process. *Id.* Additionally, all the information delivered to Fenton’s MMS server is from the user device. Paragraph [0041]. As such, Fenton does not

teach that the stored content is received from a device other than the first user device or first user.

As discussed with regard to claim 1 above, the advantages of a rejected claim over the applied references are relevant to the determination of obviousness. Because the system of claim 10 requires the stored content to be received from a device other than the first user device, the system of claim 10 allows a user to direct the transfer of multimedia messages without the first user having possession of those messages on the first user's user device. This advantage of the system of claim 10 over Kageyama in view of Fenton illustrates the non-obviousness of claim 10 at the time the application was filed.

In sum, claim 10 has limitations that are different and non-obvious over the applied art references. Accordingly, Applicants respectfully request that Examiner withdraw the rejections, under 35 U.S.C. § 103(a), of claim 10.

## **2. Claims 32 and 43**

Claim 32, as amended, recites "after said storing and identifying, receiving, at said server . . . identification of certain content . . . ." Claim 43, as amended, recites, "wherein said receiving occurs after said content has been stored and uniquely identified." Kageyama in view of Fenton does not teach these limitations. Kageyama teaches a user device capable of negotiations pertaining to the disclosure of attribute information. Abstract. The user device negotiates with a center device the information that may be shared with a second device. *Id.*; Paragraph [0057]. Kageyama does not teach after said storing and identifying, receiving identification of certain content.

Fenton discloses a system for processing multimedia messages. Abstract. In Fenton, when a message is received, a determination is made whether the multimedia message should be processed using a customized process. *Id.* Additionally, a multimedia message and delivery information regarding that multimedia message in Fenton is delivered contemporaneously. Paragraph [0041]. As such, Fenton does not teach after said storing and identifying, receiving identification of certain content.

In sum, claims 32 and 43 have limitations that are different and non-obvious over the applied art references. Accordingly, Applicants respectfully request that Examiner withdraw the rejections, under 35 U.S.C. § 103(a), of claims 32 and 43.

### **3. Claim 44**

Claim 44 depends from claim 43 and inherits the limitations of claim 43. As discussed above, Kageyama in view of Fenton does not teach all the limitations of claim 43. At least for this reason, Kageyama in view of Fenton does not render claim 44 obvious. Accordingly, Applicants respectfully request that Examiner withdraw the rejections, under 35 U.S.C. § 103(a), of claim 44.

### **4. Claim 51**

Claim 51 requires, “identifying at least a portion of multi-media content to a user, said portion having a unique identification associated therewith . . . .” Examiner incorporates the assertions made in the previous Office Action to reject claim 51. Office Action, pages 6 – 7. In the previous Office Action, Examiner asserted that based on Fenton paragraph [0066], Fenton’s MMS user agent identifies multimedia content having a unique identification and thus Fenton teaches the limitations of claim 51. Examiner’s assertion is incorrect. Paragraph [0066] describes that:

If a MMS User Agent 102, 104, 106, 108, 110 and 112 supports submission of multimedia messages, the MMS User Agent . . . should: . . . identify the MIME content type of the message. . . .  
Upon reception of a multimedia message from an originator MMS User Agent 102, 104, 106, 108, 110 and 112, the originator MMSE: will assign a Message Identification to the multimedia message . . . . Fenton, paragraph [0066](emphasis added).

Thus, in Fenton, the MMS User Agents identify the content type of the multimedia—note content type is not a unique identifier. Then, the MMS User Agent sends the multimedia message to the MMSE. The MMSE then assigns a message identification to the multimedia message. Because the originator MMSE receives the multimedia message from the MMS User Agent, when the MMS User Agent identifies the MIME content type, Examiner’s

asserted unique identification has not yet been applied to the multi media message. Fenton's MMS user agent, therefore, does not identify multi media content that has a unique identification.

Claim 51 requires "under control of said user, sending a message to a host remote from said user . . . upon receipt by said host of said message from said user, delivering said MMS message . . . at least one proposed recipient." Examiner asserted in the previous Office Action at page 11 that Fenton's Fig. 1 elements 102, 104, 106 and 108—MMS user agents—are equivalent to the claimed host system. Examiner, however, has not explicitly identified the user and the recipient with regard to this claim. It appears that Examiner is asserting that the MMS user agents represent the user, the recipient and the host remote system. Applicants submit that the fact that Examiner is interpreting the host remote to be the same as the user and the recipient illustrates the clear distinction between Fenton and claim 51, and thus Fenton cannot be used to render claim 51 obvious.

In sum, Examiner's reliance on MMS User Agents as functioning, at the same time, as a host remote, users and recipients illustrates that the applied art does not render claim 51 obvious. Accordingly, Applicants respectfully request that Examiner withdraw the rejection under 35 U.S.C. § 103(a), of claim 51.

**C. 35 U.S.C. § 103(a) Rejection over Kageyama and Fenton in view of Kontio**

Claims 11 – 21, 24 – 29, 31, 33 – 42, 45 – 50 and 52 – 55 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Kageyama and Fenton as applied to parent claims 1, 10 and 32 above in view of Kontio. Claims 11 – 21, 24 – 29 and 31 depend from claim 10 and inherit all the limitations of claim 10. Claims 33 – 42 depend from claim 32 and inherit the limitations of claim 32. Claims 45 – 50 depend from claim 43 and inherit the limitations of claim 43. Claims 52 – 55 depend from claim 51 and inherit the limitations of claim 51. As discussed above, Kageyama in view Fenton does not teach all the limitations of claims 10, 32, 43 and 51. Kontio does not cure the deficiencies of Kageyama in view Fenton. Therefore, Kageyama in view Fenton and further in view of Kontio does not render claims 11 – 21, 24 – 29, 31, 33 – 42, 45 – 50 and 52 – 55 obvious. Accordingly, Applicants

respectfully request that Examiner withdraw the rejection under 35 U.S.C. § 103(a), of claims 11 – 21, 24 – 29, 31, 33 – 42, 45 – 50 and 52 – 55.

**D. 35 U.S.C. § 103(a) Rejection over Kageyama, Fenton and Kontio in view of Lewis**

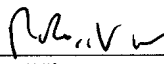
Claims 22 – 23 and 30 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Kageyama, Fenton and Kontio as applied to parent claim 24 above in view of Lewis. Claims 22, 23 and 30 depend from claim 10 and inherit the limitations of claim 10. As discussed above, Kageyama in view Fenton and further in view of Kontio do not teach all the limitations of claim 10. Lewis does not cure the deficiencies of Kageyama in view Fenton and further in view of Kontio. Therefore, the combination of Kageyama in view Fenton and further in view of Kontio and further in view of Lewis does not render claims 22, 23 and 30 obvious. Accordingly, Applicants respectfully request that Examiner withdraw the rejection under 35 U.S.C. § 103(a), of claims 22, 23 and 30.

**IV. Conclusion**

In view of the above, Applicants believe the pending application is in condition for allowance. Applicants believe no fee is due with this response. Please charge any fees required or credit any overpayment to Deposit Account No. 06-2380, under Order No. 64032/P006US/10303189 during the pendency of this Application pursuant to 37 CFR 1.16 through 1.21 inclusive, and any other sections in Title 37 of the Code of Federal Regulations that may regulate fees.

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Respectfully submitted,

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